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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,856	03/05/2002	Mark S. Leung	12361-8US	8363
20988	7590	03/01/2004	EXAMINER	
OGILVY RENAULT 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			ROANE, AARON F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/087,856

Applicant(s)

LEUNG ET AL.

Examiner

Aaron Roane

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-18 is/are allowed.
- 6) ☒ Claim(s) 1,3-13,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 5-8, 10, 12, 13, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rittman, III et al. (USPN 6,575,969 B1).

Regarding claims 1, 3, Rittman, III et al. disclose a system comprising a plurality of probes (101, 201, 301, 401 or 501) wherein the distal portions of each probe comprises an

energy delivery means (an electrical “rf element” see col. 2, lines 12-57), and a cooling means (122 with 141) for cooling tissue adjacent energy delivery means, see col. 2-5 and figures 1-11.

Regarding claims 5, 6 and 12, Rittman, III et al. further disclose that the system is capable of providing ablative energies and also of monitoring the temperature via at least one temperature sensor (104), see col. 1 and 2, especially col. 12, line 44 through col. 16, line 37. Therefore, the invention of Rittman, III et al. is fully capable of providing energy delivery sufficient to perform the intended use or desired result and capable of maintaining a particular temperature.

Regarding claim 7, Rittman, III et al. further disclose an impedance meter (844) to determine the impedance between the probes, see col. 17, line 34 through col. 22, line 18 and figure 8.

Regarding claim 8, Rittman, III et al. disclose the claimed invention, see figure 8.

Regarding claim 10, Rittman, III et al. disclose the claimed invention of an external elongate portion of at least one probe with electrical insulation (102), see figure 1 and col. 5.

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Regarding claim 13, Rittman, III et al. disclose the claimed invention. Any shape disclosed by Rittman, III et al. provides the directed energy between the probe tips.

Regarding claim 19, Rittman, III et al. disclose a system comprising a plurality of probes (101, 201, 301, 401 or 501) wherein the distal portions of each probe comprises an energy delivery means (an electrical “rf element” see col. 2, lines 12-57), and a cooling means (122 with 141) for cooling tissue adjacent energy delivery means, see col. 2-5 and figures 1-11. Rittman, III et al. further disclose that the system is capable of providing ablative energies and also of monitoring the temperature via at least one temperature sensor (104), see col. 1 and 2, especially col. 12, line 44 through col. 16, line 37.

Therefore, the invention of Rittman, III et al. is fully capable of providing energy delivery sufficient to perform the intended use or desired result and capable of maintaining a particular temperature.

Regarding claim 20, Rittman, III et al. disclose a system comprising a plurality of probes (101, 201, 301, 401 or 501) wherein the distal portions of each probe comprises an energy delivery means (an electrical “rf element” see col. 2, lines 12-57), and a cooling means (122 with 141) for cooling tissue adjacent energy delivery means, see col. 2-5 and figures 1-11. Rittman, III et al. further disclose an impedance meter (844) to determine the impedance between the probes, see col. 17, line 34 through col. 22, line 18 and figure 8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rittman, III et al. (USPN 6,575,969 B1) in view of being well known in the art as shown by Eggers et al. (USPN 5,928,159).

Regarding claim 4, Rittman, III et al. disclose the claimed invention except for explicitly reciting the frequency of operation is 20 kHz. It well known in the art to provide electrical energy delivery in a variety of wavelengths including 20 kHz depending on the desired effect. Eggers et al. disclose a system (100) for treating tumors comprising a first and second elongate probe (110), wherein the distal end of the probe comprises a energy delivery means (electrodes on 113), see col. 7, lines 18-67 and figure 5. The energy delivered by the energy delivery means is in the form of radio frequency electrical current with a frequency of 20 kHz to 20 MHz, see col. 5, lines 58-67. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Rittman, III et al., as is well known in the art and shown by Eggers et al., to

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provide electrical energy delivery in a variety of wavelengths including 20 kHz depending on the desired effect.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rittman, III et al. (USPN 6,575,969 B1) in view of being well known in the art as shown by Panescu et al. (USPN 6,053,912).

Regarding claim 11, Rittman, III et al. disclose the claimed invention except for providing a shape control means for changing the shape of the probe. Panescu et al. disclose a device and method comprising an rf electrode (16), a cooling means (40), see col. 4-6 and figures 1-4. Panescu et al. also teach the inclusion of a steering means or shape control means (26 and 38) in order to place the electrode against the desired target tissue, see col. 4 and 5 and figure 1A. Therefore, at the time of the invention, it would have been obvious to modify the invention of Rittman, III et al., as taught by Panescu et al., to include a steering means or shape control means in order to place the electrode against the desired target tissue.

***Response to Amendment***

The examiner acknowledges the amendments to the claims in order to overcome the objections and 112 rejections. These amendments overcome the previously made objections and 112 rejections.

The examiner acknowledges the amendments made to the claims regarding the cooling means. New art has been applied to reject the claims. Additionally, claim 11 was not rejected in the first office action and therefore this action is NON-FINAL.

***Allowable Subject Matter***

Claims 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 15-18 are allowed.



***Conclusion***

Due to the above mention omission of a rejection of claim 11 in the first office action,  
**this rejection is NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*  
February 23, 2004

*Roy D. Gibson*  
**ROY D. GIBSON**  
**PRIMARY EXAMINER**